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TS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/999,308 12/29/97 FUJINO

N FUJ014691

EXAMINER

TM02/0209

HELFGOTT & KARAS
EMPIRE STATE BUILDING
60TH FLOOR
NEW YORK NY 10118-0110

ENG. G ART UNIT	PAPER NUMBER
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2643
DATE MAILED:

02/09/01

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

6

Office Action Summary

Application No.
08/999,308

Applicant(s)
Fujino et al.

Examiner
George Eng

Group Art Unit
2643



☒ Responsive to communication(s) filed on Jan 25, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-6 and 8-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-6 and 8-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response

1. The Response filed 6/28/2000 (paper no. 13) has been considered in preparing this Office action.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-6 and 8-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Shachar et al. (US PAT. 5,764,736 hereinafter Shachar).

Regarding claim 1, Shachar discloses a communication system as shown in figure 1 comprising a server (124) providing information, a terminal (100) communicating data with the server, and a communication network (122) connecting said server to said terminal (col. 7 line 38 through col. 8 line 26), wherein the system further comprises a temporary line disconnection unit for temporary disconnecting a line being used for primary data communication without issuing any

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disconnection notifications of the terminal when a third party other than the server is being voice communicated during a data communication between the terminal and the server (figure 4b and col. 14 lines 2-20), a data fetch unit for automatically fetching data from the server to the terminal (figure 4a and col. 13 lines 7-40), a storage unit for storing data fetch by said automatic data fetch unit (col. 13 lines 62-66), wherein a data communicating process is preformed from a status at a point immediately before starting the voice communication when said server and said terminal resume the data communication (figure 4c, col. 12 lines 34-57 and col. 14 lines 41-51). Note while Shachar teaches the communication system is able to download information from the server during data communication in the storage unit and to access the storage unit in order to accomplish various tasks (col. 8 lines 51-67, col. 10 lines 33-49 and col. 11 lines 35-41) so that the communication is capable of providing virtual data communication during voice communication. Therefore, the claimed limitations are met by Shachar.

Regarding claim 2, Shachar teaches the terminal obtaining a telephone number of the third party as information during the data communications (col. 10 lines 54-60).

Regarding claims 3-5, Shachar teaches the server comprising a telephone switch unit and the temporary line disconnecting unit provided in the terminal and the server for disconnecting between the terminal and the server when the terminal issues a request for voice communication with the third party (col. 11 line 7 through col. 12 line 49).

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Regarding claims 6 and 8, Shachar discloses at least one unit provided on a server side for each use who receives a service of said server for managing personal information and communications status of each user (col. 9 lines 4-17 and col. 12 lines 23-49).

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claims 11-13, the limitations of the claims are rejected as the same reasons set forth in claims 3-5.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claims 6 and 8.

Response to Arguments

4. Applicant's arguments filed 1/25/2001 (paper no. 16) have been fully considered but they are not persuasive.

In response to applicant's argument that Shachar is different configuration from that of the claimed invention because Shachar is possible to perform both voice and data communication simultaneously, but the claimed invention is not logically possible to establish communications occurring simultaneously with both voice and data communications. Although Shachar discloses one embodiment of performing both voice communication and data communication at the same time (col.

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8 lines 6-43), Shachar also teaches another embodiment of connecting a terminal at a given time via a communication line to perform either voice communication or data communication due to a communication network is not possible for simultaneous voice and data communication. As shown in col. 12 lines 1-18, Shachar discloses the steps of switching a data communication and a voice communication such that a current data connection is suspended, i.e., disconnected, as a voice connection is established. In addition, the abstract clearly discloses the technique of switching from a data session to a voice session comprising the steps of establishing a primary data connection between a user terminal and a communication network, providing the user terminal with a tag identifying a voice network address (i.e., address of a service provider), initiating a voice connection with the service provider, suspending the data session during voice session, and resuming the primary data session upon completion of the voice session. Thus, the limitations of the claims are met by Shachar.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the

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date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

(703) 308-6296 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

GEORGE ENG

February 6, 2001


CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600